

REMARKS

This application has been reviewed in light of the Office Action dated May 18, 2006. Claims 11-15, 17-23 and 25-32 are presented for examination, of which Claims 11, 19, 27, 29 and 31 are in independent form. Claims 12 and 20 have been canceled, and their recitations incorporated into their respective base claims; these actions are taken without prejudice or disclaimer of subject matter, and the canceled claims will not be mentioned further. In addition, Claims 28, 29 and 31 have been amended to define still more clearly what Applicant regards as his invention. Favorable reconsideration is respectfully requested.

Applicant notes that, despite Applicant's request in his last Amendment, the outstanding Office Action again does not mention Applicant's claim to priority benefit under 35 U.S.C. § 119. Since a Claim to Priority and a certified copy of Applicant's priority application were filed on December 21, 2001, and are reflected in PAIR, Applicant understands that the lack of express acknowledgment in the Office Actions thus far is simply an oversight, and that the priority information will be printed on any patent that may issue from this application, as claimed by Applicant. If Applicant's understanding is not correct, the Examiner is respectfully requested so to indicate in his next paper.

In the Office Action, Claims 11, 13, 14, 19, 21 and 22 were rejected under 35 U.S.C. § 103 as being obvious from U.S. Patents 5,978,557 (Kato), 6,912,057 B1 (Idehara) and 5,056,769 (Ikenoue et al.) in combination, Claims 15 and 23, as being obvious from those three patents, further in view of U.S. Patent 5,513,839 (Green), Claims 17, 18 and 25-28, as being obvious from those three patents, and Claims 29-32, as being obvious from *Kato* in view of *Idehara*.

Claim 11 is directed to an information processing apparatus connected to a first printer and a second printer. The apparatus comprises a discriminating unit, an output unit and a controller. The discriminating unit discriminates to which of the printers each page of print information is outputted. When that unit discriminates that a certain page is to be outputted to the first (second) printer, the output unit outputs the page to the first (second) printer. The controller adds control information for switching ejecting positions regarding the pages in which the succession of page numbers is broken to the print information which is outputted to the first (second) printer in a manner such that the pages are sorted and ejected on an output page unit basis of the succeeding page numbers in the printer in question.

It is very important, in an apparatus constructed according to Claim 11, that the recited control information is added. This control information, as recited, is for switching ejecting positions regarding a set of pages in which the succession of page numbers is broken, and is added to the print information which is outputted to the first or second printer, respectively, in a manner such that the pages are sorted and ejected on an output page unit basis of the succeeding page numbers in the printer. The print information of each page is given a specific ejecting position such that the pages are sorted and ejected with proper succeeding page numbers.

Kato and *Idehara* have been discussed previously. In this regard, Applicant notes that *Kato* relates to a system in which, for each page, a determination is made as to whether any color information is present in the page (see Fig. 4). Any page containing color data is sent to a color printer to be printed, while the other pages are printed at a monochrome printer. The operator can instruct the system to insert a dummy page in each

set of printed pages to indicate where one or more pages from the other set need to be inserted (an example of such a dummy page is shown in Fig. 11). If the total size of the job is small, however, the operator may designate that no dummy pages are to be produced. The *Kato* system, however, does not provide the user with the ability to designate a particular ejection destination (sorter bin) in the color printer or in the monochromatic printer.

Idehara relates to an image forming apparatus that sorts print data into monochromatic pages and color pages, as shown in Figs. 3A-3C. Instead of printing all the pages in order, the image forming apparatus prints all the color pages, and then all the monochromatic pages, or *vice versa*. This is done to avoid having to switch the apparatus between color printing and monochrome printing repeatedly (since each such switch requires time). To facilitate the operator's putting the printed pages into the correct order, the apparatus switches ejection bin whenever it detects a discontinuity in the page numbering. As a result, each bin used contains only consecutively-numbered pages, and the operator need only put the respective sets into the correct order. For this purpose, however, it is noted that *Idehara* provides a complicated bin-switching function (Figs. 2A-2B) for sorting the print data into monochromatic pages and color pages, as shown in Figs. 3A-3C.

Ikenoue relates to a system that uses a host computer to send print data with a print control command to a printer, which receives the print data and the print control command from the host computer and executes printing of the print data based on the print control command.

The Office Action asserts that these three patents “are combinable because they are from the same field of endeavor, namely print document handling systems.” (Office Action, at page 3.) To the extent that the Office Action in saying this is merely asserting that the three documents are not non-analogous art, Applicant agrees. Nonetheless, it is not agreed that the proposed combination would have been obvious for a person of merely ordinary skill, at least because the approaches of *Kato*, which divides the job into two parts, which are sent to two different printers, and *Idehara*, which uses a *single* printer, and divides the print job into a color portion and a monochromatic portion, appear to be somewhat contradictory.

Even assuming that one of ordinary skill would nonetheless have found it obvious to attempt to combine these three patents, Applicant strongly believes that the result of the proposed combination would not in fact have met the terms of Claim 11. Rather, the proposed combination would merely lead to a color-monochromatic distribution printing system, basically like that of *Kato*, but having a plurality image forming apparatuses, as in *Idehara*, in which each image forming apparatus would receive a print control command from a host computer, as in *Ikenoue*. The print control command provided by *Ikenoue*, however, is completely different from the control information for switching ejecting positions for the pages in which a succession of page numbers is broken, as is recited in Claim 11.

Thus, the proposed combination would still not have a controller as is recited in Claim 11, which “*add[s] control information* for switching ejecting positions regarding the pages in which a succession of page numbers was broken *to the print information* which is outputted to the first printer by said output unit in a manner such that

the pages are sorted and ejected on an output page unit basis of the succeeding page numbers in the first printer [emphasizes added]". As far as can be seen, in the *Idehara* apparatus, the page numbering itself appears to be used to determine when it is time to switch to a new bin (col. 4, lines 47-51); Applicant submits that nothing has been found, or pointed out, in that patent that would teach or suggest adding control information to the image information. In the *Kato* apparatus, on the other hand, a flag that is set upon detection of color information in a page is used to determine which pages go to which printer (see Fig. 4). Applicant submits that nothing in either patent, nor in both taken together, would teach or suggest adding control information to the image information, or a controller for that purpose, as recited in Claim 11. Accordingly, Applicant submits that Claim 11 is allowable over *Kato*, *Idehara* and *Ikenoue*, taken separately or in any permissible combination (if any).

Independent Claims 19 and 27 are method and program claims, respectively corresponding to apparatus Claim 11, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 11.

Independent Claim 29 is directed to an information processing apparatus for communication with a plurality of printers including a color print control apparatus and a monochromatic print control apparatus, comprising a discrimination unit, a determination unit and first and second output units. The discrimination unit discriminates whether print data to be output to any of the plurality of print control apparatuses is color data or monochromatic data. Based on the discrimination, the determination unit determines whether the print data is to be output either to the color print control apparatus or to the monochromatic print control apparatus. When the determination unit determines that the

print data is to be output to the color (monochromatic) print control apparatus, the first (second) output unit outputs the print data to the color (monochromatic) print control apparatus with a designation of a first (second) ejection destination. The first (second) output unit outputs a certain page while maintaining the designation of the first (second) ejection destination, if the page is serial to a previously outputted page, and outputs a certain page together with a designation changed from the designation of the first (second) ejection destination, if the page is not serial to the previously outputted page.

Among the notable features of the apparatus of Claim 29, therefore, is that print data of each page is outputted either to a color print control apparatus or to a monochromatic print apparatus with a designation of an ejection destination, and that a given page is outputted with the designation of the ejection destination maintained, if the page is serial to (that is, numbered consecutively with) the preceding page, but is outputted together with a changed designation of the ejection destination, if the page is not serial to the preceding page.

Claim 29 is believed to be allowable over for reasons similar to those set out above with regard to Claim 11: the proposed combination of references, assuming that it would be a permissible one, would still not result in an apparatus having the recited first and second output units that provide the designation of the ejection destination as recited in independent Claim 29.

Independent Claim 31 is a method claim corresponding to apparatus Claim 29, and is believed to be patentable for at least the same reasons as discussed above in connection with Claim 29.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

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